

Appl. No. : 10/608,598
Filed : June 27, 2003

REMARKS

Rejections under 35 USC §103

The Examiner rejected Claims 1-11, 13-16, 19 and 22 as being obvious over Huang (US 5,695,418) in view of Haseyama and Yasui. According to the Examiner, Huang teaches an elastomer layer (polyurethane) bonded to a textile layer (felt), but does not teach an antimicrobial agent. The Examiner cited Haseyama as teaching antimicrobial additives for urethane elastomers used as golf club grips (but Haseyama lacks any disclosure related to any particular antimicrobial additives). Finally, Yasui is cited by the Examiner as teaching antimicrobial agents comprising silver combined with a silica-alumina for use in elastomer fishing pole grips.

Applicant respectfully asserts that the Examiner has failed to establish a *prima facie* case of obviousness for the following reasons. Under MPEP §2143, “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.” Applicant respectfully suggests that the references themselves lack adequate suggestion or motivation to combine, and provide no reasonable expectation of success.

While Applicant’s earlier patent teaches an elastomer layer (polyurethane) bonded to a textile layer (felt), Haseyama and Yasui fail to motivate and/or enable one of skill in the art to modify the very distinct two layered grip of Huang to arrive at Applicant’s improvement. The published Haseyama application teaches an apparatus and method for making a highly foamed urethane-based thermoplastic elastomer, wherein CO₂ is added to a molten elastomer to produce stable foams having uniform cells. Haseyama mentions among a laundry list of “Other Additives” in paragraph [0162] that an “antimicrobial/antifungal agent” may be optionally used. Likewise, Haseyama also mentions golf grips among a list of possible applications that extends for ten (10) full paragraphs [0385-0394], including *inter alia* automobile parts, cellular phones, fountain pens, wire coatings, and sanitary products.

However, Haseyama does not provide any exemplary antimicrobial/antifungal agents, and certainly not Applicant’s inorganic antimicrobial agent. Nor does Haseyama teach how such

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additives might be incorporated into either the disclosed thermoplastic or Applicant's very different polyurethane elastomer. Nor does Haseyama provide any indication as to whether the undisclosed antimicrobial/antifungal additive would retain any of its antimicrobial activity after addition to his molten elastomer, foaming and cooling. Indeed, the manufacturing process disclosed by Haseyama is entirely different from Applicant's process (detailed in paragraphs [040-041]); the resulting products are accordingly quite different. Briefly, Applicant describes coating a textile layer with a DMF-dissolved polyester or polyether, coagulating the urethanes in water (which replaces the DMF), and subsequently displacing the water with air under pressure at elevated temperature, wherein closed vertical cells are produced. Instead, Haseyama teaches melting a thermoplastic polyurethane resin to a temperature of 230° C, injecting the molten thermoplastic with CO₂ and kneading the mixture during cooling to yield stable elastomer foams. Thus, Haseyama provides no more than an invitation to go fishing with no guidance as to the active agent, the grip configuration, and/or how to incorporate the agent into the process to yield an antimicrobial grip. Moreover, lacking the supporting disclosure or any data and/or working examples, Hasayama provides the skilled artisan with no expectation of success.

Yasui fails to cure the defective combination. Yasui teaches molded grips and handles for a variety of fishing equipment, including rods & reels, coolers, rod bags, nets, and bait boxes. The grips comprise synthetic thermoplastic resins and a germicidal material. The germicidal materials disclosed include inorganic agents, such as metals (e.g., silver and zinc) combined with a porous carrier (e.g., calcium phosphate, silica-alumina, zeolite, and zirconium phosphate). The preferred germicidal materials were BACTEKIRANI (silver and zeolite) and NOVALON (silver and zirconium). The grips are made by melting thermoplastic resin pellets together with pellets containing the germicidal material, wherein the grips/handles are then molded (e.g., via injection molding) to yield the appropriately shaped grips/handles. Thus, like Haseyama, thermoplastic resins are melted at very high temperatures. The melting and injection molding process of Yasui are very different from Applicant's process of coagulating soluble urethanes on a textile layer. Accordingly, there is no relevant teaching in Yasui that would enable one to modify Huang to make Applicant's antimicrobial grips. Indeed, because of the differences in process conditions and resulting elastomers between Huang and both Haseyama and Yasui, one skilled in the art would not be motivated to combine the references. Furthermore, one of skill in the art would not have any expectation of success even if Huang was modified to include the additive of Yasui.

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Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection of Claims 1-11, 13-16, 19 and 22 under §103.

The Examiner also rejected Claims 12, 17-18, 20-21 and 23-24 as being obvious over Huang in view of Haseyama, Yasui and Applicant's disclosure of the silver and montmorillonite antibacterial powder.

First, Applicant respectfully asserts that Applicant's disclosure that "Nanometers Layeric Silver System Inorganic Antibacterial Powder" is a complex of silver and montmorillonite made by Bejing STR Inc., Ltd. is not properly combinable, as prior art, with the other references. Under MPEP §2143, "...The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." Moreover, there is no admission or even any indication that any information or materials related to this antibacterial powder are in the prior art. Further, Applicant's disclosure that the use of any particular antimicrobial agent accords with one preferred embodiment of his invention, is irrelevant because the invention as claimed does not recite a particular antimicrobial agent, but rather recites concentration ranges of known compounds. Thus, because the references themselves (Huang, Haseyama and Yasui) fail, as discussed above, to provide sufficient motivation to combine and/or any expectation of success, and because the addition of Applicant's own disclosure is improper and provides no relevant teaching or further motivation, Applicant respectfully requests reconsideration and withdrawal of the rejections of Claims 12, 17-18, 20-21 and 23-24 over the same references combined with Applicant's disclosure.

CONCLUSION

In view of the above Remarks, Applicant respectfully requests withdrawal of rejections of the claims and assert that the present application is in condition for allowance. Should there be any questions concerning this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number appearing below.

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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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By:



Mark R. Benedict
Registration No. 44,531
Attorney of Record
Customer No. 20,995
(949) 760-0404

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